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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SAGER, MARK ALAN	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/612,301	TOYODA, HIROBUMI	
	Examiner	Art Unit	
	M. A. Sager	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11/1/06, 1/27/06, 5/25/06 and 12/1/03*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/1/06, 1/27/06, 5/25/06 and 12/1/03.

Claim Objections

1. Claim 5 is objected to because of the following informalities: the claim appears to be preamble with no defined body, also spelling of 'wining' (line 5) rather than --winning--. Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Regarding claim 8, the computer executable program is a computer program that is not stored on computer readable media, as claimed, and thus is a program which is non-statutory subject matter. Essentially, a computer program per se is non-statutory subject matter. Regarding claim 9, a storage medium storing the program of claim 8 is a medium that records/stores program code, which can be paper. Thus, claim 9 is non-statutory due to the non-functional descriptive material of the program is not claimed in a relationship with a computer readable media or being processed by a processor/computer so as to realize its functionality and thus lacks producing a concrete, tangible or useful result therefrom. Since there is no inter-relationship between claimed storage medium and the program to realize its functionality, it is claiming non-functional descriptive material such as program code drafted or printed on paper so as to be stored thereon. It is noteworthy that such recordation of printed works should be considered for copyright rather than utility patent. Also, since there is no inter-relationship between claimed medium and program to realize its functionality, the claimed invention fails to produce a concrete, tangible or useful result in so far as there is no inter-

relationship between medium and program for a concrete, tangible or useful functionality to be realized. As an example of claim scope, the storage medium is paper that stores written lines of program code which although the program is for use in a computer/computing device, the functionality of the program cannot be realized in its form recorded on the paper, (i.e. a computer cannot impart functionality of steps of program while it is merely recorded/stored on paper). Adding 'computer readable' to storage medium properly addresses the shortfall of present claimed scope regarding claim 9. See *State Street*, 149 F.3d at 1374-1375, 47 USPQ 2d at 1602. See *AT&T Corp. V. Excel Comm. Inc.*, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Also, the PTO web site at http://www.uspto.gov/web/patents/guides.htm provides guidance for claiming inventions relating to program code in Examination Guidelines for Computer-Related Inventions & Training Materials.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-3, 5-9 are rejected under 35 U.S.C. 102(e) as anticipated by Pascal (6287202) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pascal (6287202) in view of Guinn (6039648) or Encyclopedia of Games, by John Scarne, hereafter Scarne. Pascal discloses a tournament gaming machine, server, system, program and memory media (figs. 1-3B) teaching gaming machine (abstract, fig 1, ref 14) having individual display parts so as to display player game content such as card indicia for poker game (4:6-33, 5:23-44, fig 1, ref 14), a common display part which shows common information shared with other players (5:40-43), operating parts which is operated by each individual player as input buttons or switches for game operation is inherent to poker game machine (abstract, fig 1-3B), a server connectable via communication line to terminal devices (fig. 1, ref 16), a game control means for controlling a card game that is played by a plurality of players including a virtual player (2:59-4:63, 7:12-24), a benefit provision means for providing benefits to said players in accordance with game media used in the card game (4:34-42, 7:1-24), further comprising rank determination means for determining a player ranking in accordance with a result of the card game (7:1-24), a win/loss determination means for determining winning players among the plurality of players to be provided with

benefits based on the player ranking determined by said rank determination means wherein said win/loss determination means determines the winning players including a highest ranking player and a player other than a second highest ranking player according to the player ranking, such as prizes for first through third or first through fifth place as conventional in tournaments having multiple rank ordered winners, whereby designated winning players of ranking first and third or first and third through fifth meets a player other than second highest. It is noted that an inventor does not have to disclose within their written specification material which is well known or conventional to an artisan and preferably omits material which is well known or conventional Such is the case here with respect to Pascal stating determining winning players (5:19-22) such that the winning players include a highest ranking player and a player other than second highest ranking player according to player ranking (such as first through fifth, whereby first and third through fifth includes other than second highest ranking player). As evidence under MPEP 2131.01 of multiple rank ordered winners, see Guinn (6039648, 5:14-17, 29-45) or the annual poker tournaments (World Series of Poker held at Binion's Horseshoe Casino from 1971 through 2000) where first through sixth ranked winners were determined and awarded prizes or various other tournaments including golf, bowling or any other sport or competition that similarly include multiple ranked winners. Further alternatively, there is a version of poker known as high-low poker (see Scarne, pg 2-11) that includes determining winning players that includes a highest ranking player and a player other than second highest ranking player such as lowest ranking according to player ranking. Pascal includes poker games (4:6-33) and thus includes high low poker; thereby, also inherently includes a highest ranking player and a player other than a second highest ranking player such as lowest ranking according to player ranking.

Alternatively, Pascal lacks disclosing winning players that includes a highest ranking player and a player other than second highest ranking player such as lowest ranking according to player ranking. Guinn discloses a tournament system (5:14-17, 29-45) wherein said winning players include a highest ranking player and a player other than second highest ranking player according to player ranking (such as first through fifth, whereby first and third through fifth includes other than second highest ranking player) for multiple ranked player winners or Scarne discloses an encyclopedia of card games that include versions of high-low poker (pages 6-11, 22-23, 39-42) and demonstrate high-low poker includes winning players include a highest ranking player and a player other than second highest ranking player according to player ranking such as a lowest ranking player which due to high low aspect provides increased interest in play due to added strategy. Thus, it would have been obvious to an artisan at a time prior to the invention to add winning players include a highest ranking player and a player other than second highest ranking player according to player ranking as taught by either Guinn or Scarne to Pascal so multiple player may win awards which increases interest in playing.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pascal or over Pascal in view of either Guinn or Scarne as applied to claim 1 above, and further in view of Huard (5743800) or Place (5707285). Pascal or Pascal in view of either Guinn or Scarne discloses claimed gaming machine (sic) except lottery. Huard (abstract, 3:13-17, 55-64, 4:13-25, 5:61-6:5) and Place (5:58-59, 6:6-8, 12-23) disclose gaming machine having a lottery to determine a winning player that provides interest for player to play. Therefore, it would have been obvious to an artisan at a time prior to the invention to add lottery as taught by either Huard

or Place to Pascal or to Pascal in view of either Guinn or Scarne to provide interest for player to play.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dote discloses a gaming machine showing virtual dealer. Bridgeman discloses imitative virtual opponent. Miers discloses virtual opponent. Wesley Steiner discloses bicycle poker game that includes virtual opponent.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. A. Sager
Primary Examiner
Art Unit 3712

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